UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,842	07/07/2001	Erik J. Freed	01-100	7813

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EXAMINER
NGUYEN, VAN H

ART UNIT	PAPER NUMBER
2194	

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/900,842	FREED, ERIK J.
	Examiner	Art Unit
	VAN H. NGUYEN	2194

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 June 2005</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-63</u> is/are pending in the application.
   4a) Of the above claim(s) <u>16-45</u> is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-15 and 46-63</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1.   Applicant's election of group I (claims 1-15 and 46-63), filed June 10, 2005 is

acknowledged. Because applicant did not distinctly and specifically point out the supposed

errors in the restriction requirement, the election has been treated as an election without traverse

(MPEP § 818.03(a)).

2.   Claims 1-63 are pending in this application. Claims 16-45 are withdrawn from

consideration.

3.   Applicant is required to cancel non-elected claims 16-45 in the next response to this

office action.

Oath/Declaration

4.   The Office acknowledges receipt of a properly signed oath/declaration filed June 28,

2002.

Specification

5.   The lengthy specification has not been checked to the extent necessary to determine the

presence of all possible minor errors. Applicant's cooperation is requested in correcting any

errors of which applicant may become aware in the specification.

Claim Objections

6.   Claims 12 and 15 are objected to because of the following informalities:

"the logic" (claim 12, line 1 and claim 15, line 1) should read "the logic module"

Appropriate correction is required.

Claim Rejections - 35 USC § 101

7.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8.   The language of independent claims 1, 2, 5, 8-10, 13, and 46 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or <u>machine</u> which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

9.   If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. <u>In re Schrader</u>, 22 F.3d 290 at 294-95, 30 USPQ2d 1455 at 1458-59 (Fed. Cir. 1994).

10.   Claims 1, 2, 5, 8-10, and 13 are rejected under 35 U.S.C. 101 because the claimed invention, appearing to be comprised of <u>software alone</u> without claiming associated <u>computer hardware</u> required for execution, is not supported by either a specific and substantial asserted utility (i.e., transformation of data) or a well established utility (i.e., a practical application).

11.   Independent claim 46 does not appear to require any computer hardware to implement

the claimed invention. The claim appears to define the metes and bounds of an invention

comprised solely of software. There is no support (i.e., explicitly claimed computer hardware) in

the body of claim 46 to support "a system" of the preamble. Likewise, the "system" of the

preamble of claim 46 appears to be a system comprised entirely of software.

12.   Independent claims 58 and 59 are rejected under 35 U.S.C. 101 because the claimed " a

medium" is not tangibly embedded in a computer system.

Claim Rejections - 35 USC § 102

13.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14.   Claims 1-15 and 46-63 rejected under 35 U.S.C. 102(e) as being anticipated by **Cullen et**

al (US 6,272,528 B1 B1).

15.   **As to claim 8,** Cullen teaches the invention as claimed including a process-container *(the*

mobile agent; col.1, lines 51-63) comprising:

a logic module *(means for obtaining details of a user's requirements and for obtaining*

financial information from the server computers on behalf of the user in the light of the user's

requirements; col.1, lines 52-56);

a storage module *(a user preferences and profile store, for storing information about*

users; col.2, lines 32-33) communicatively coupled to the logic module; and

an interface module *(means for transporting said mobile agent over the network to the*

user computer of said user, and for delivering the financial information to the user at the user

computer; col.1, lines 57-60) communicatively coupled to the logic module.

16.   **As to claim 9,** it includes the same limitations as claim 8 above, and is similarly rejected

under the same rationale.

17.   **As to claim 10,** the rejection of claim 8 above is incorporated herein in full. Additionally,

Cullen further teaches a presentation module *(see the presentation discussion beginning at col.4,*

line 51) and a data module coupled to the presentation module *(obtain performance comparisons*

on behalf of the user, in the light of the user's requirements, and then report back with the most

suitable product; col.2, lines 14-17).

18.   **As to claim 11,** Cullen teaches a journal module *(the agent-manager agent then travels*

to the user's computer; col.5, lines 7-8).

19.   **As to claim 12,** Cullen teaches the logic is coupled to the data module *(see the mobile*

agent discussion beginning at col.1, line 5).

20.   **As to claim 13,** Cullen teaches the invention as claimed including a process-container

(the mobile agent; col.1, lines 51-63) comprising:

a data module *(obtain performance comparisons on behalf of the user, in the light of the user's requirements, and then report back with the most suitable product; col.2, lines 14-17)*;

a logic module *(means for obtaining details of a user's requirements and for obtaining financial information from the server computers on behalf of the user in the light of the user's requirements; col.1, lines 52-56)* coupled to the data module; and

a presentation module *(see the presentation discussion beginning at col.4, line 51)* coupled to the data module.

21.   **As to claim 14,** Cullen teaches a journal module *(the agent-manager agent then travels to the user's computer; col.5, lines 7-8)*.

22.   **As to claim 15,** Cullen teaches the logic is coupled to the journal module *(col.5, lines 7-19)*.

23.   **As to claim 46,** Cullen teaches *(col.1, lines 48-67)* the invention as claimed including a system *(a computer system)* for automating a process *(the task)* comprising:

at least one process-container *(at least one mobile agent)*; and

at least one peer *(user computers)*;

wherein the at least one process-container includes data and instructions *(details of a user's requirements and for obtaining financial information)* relevant to a process *(the task)* and wherein the at least one peer is operable to execute the instructions *(delegate the task of finding information to the mobile agent)*, transmit *(transporting said mobile agent)* the process-container, and receive *(the agent-manager agent then travels to the user's computer... the agent-manager agent presents its tailored interface to the user; col.4, lines 7-11)* the process-container.

24.   **As to claim 47,** Cullen teaches the at least one process-container is mobile *(mobile agent;*

col.1, lines 51-60).

14.   **As to claim 48,** Cullen teaches the at least one process-container is self-contained *(many agents will need to personalise themselves based on customer lifestyle and interface preferences and in some cases the channel through which they will present themselves to users; col.3, lines 62-65).*

25.   **As to claim 49,** Cullen teaches the at least one process-container is self-contained wherein the peer is operable to execute the process-container without reference to other resources *(operating said agent-manager mobile agent in said one of said user computers to present a list of service-provider mobile agents that are available for the user to select; col.11, lines 20-24).*

26.   **As to claim 50,** Cullen teaches the at least one process-container is self-contained wherein the peer is operable to execute the process-container off-line *(some agents will work while the user is logged-out; col.3, lines 55-61).*

27.   **As to claim 51,** Cullen teaches the at least one process-container is asynchronous *(in response to a user successfully logging in to the system at one of said user computers, transporting an agent-manager mobile agent over said network from said server computer to said one of said user computers; col.11, lines 15-20).*

28.   **As to claim 52,** Cullen teaches the at least one process-container is executable *(perform a particular task for which it is designed; col.4, lines 42-43).*

29.   **As to claim 53,** Cullen teaches the at least one process-container is visualizable *(presents representations of the agents to the user; col.4, line 60).*

30.   **As to claim 54,** Cullen teaches the at least one process-container is visualizable as a web

site *(websites; col.1, line 14)*.

31.   **As to claim 55,** Cullen teaches the at least one process-container is an agent *(mobile agent; see the Abstract)*.

32.   **As to claim 56,** Cullen teaches the at least one process-container is operable to provide a communication link *(a network; col.1, lines 48-52)* to a peer *(server computers; col.1, lines 48-52)* on a remote system *(the Internet; col.3, lines 2-4)*.

33.   **As to claim 2,** Cullen teaches the invention as claimed including a method comprising:

defining a process *(delegate the task; col.1, lines 61-62)* including at least one transaction *(financial services, such as banking, general insurance, life assurance, pensions and investments, loans and mortgages, and financial planning and advisory services; see the Abstract)*;

storing a representation of the at least one transaction in a process-container *(see the mobile agent discussion beginning at col.1, line 51)*;

transmitting the process-container to at least one remote entity *(transporting said mobile agent over the network to the user computer of said user; col.1, lines 57-60)*; and

updating the process-container on the at least one remote entity *(allows the user... personalizes the presentation in accordance with the user's preferences; col.4, lines 36-54)*.

34.   **As to claim 3,** Cullen teaches receiving the process-container from the at least one remote entity *(the agent-manager agent then travels to the user's computer... arrives at the user's computer...presents its tailored interface to the user; col.5, lines 7-10)*.

35.   **As to claim 4,** Cullen teaches displaying contents of the process-container *(presents

representations of the agents to the user; col.4, line 60).

36.   **As to claim 5,** the rejection of claim 2 above is incorporated herein in full. Additionally, Cullen further teaches interacting with the process-container on the at least one remote entity *(allows the user...perform a particular task; col.5, lines 36-60).*

37.   **As to claims 6-7,** refer to discussion of claims 3-4 above for rejection.

38.   **As to claim 1,** the rejection of claim 2 above is incorporated herein in full. Additionally, Cullen further teaches receiving the process-container from the at least one remote entity *(the agent-manager agent then travels to the user's computer... arrives at the user's computer...presents its tailored interface to the user; col.5, lines 7-10);* and displaying contents of the process-container *(presents representations of the agents to the user; col.4, line 60).*

39.   **As to claim 57,** the rejection of claim 2 above is incorporated herein in full. Additionally, Cullen further teaches receive the process-container from the at least one remote entity *(the agent-manager agent then travels to the user's computer... arrives at the user's computer...presents its tailored interface to the user; col.5, lines 7-10);* and display contents of the process-container *(presents representations of the agents to the user; col.4, line 60).* A processor and a storage device are inherent to the system of Cullen.

40.   **As to claim 58,** the rejection of claim 2 above is incorporated herein in full. Additionally, Cullen further teaches receiving the process-container from the at least one remote entity *(the agent-manager agent then travels to the user's computer... arrives at the user's computer...presents its tailored interface to the user; col.5, lines 7-10);* and displaying contents of the process-container *(presents representations of the agents to the user; col.4, line 60).* A processor is inherent to the system of Cullen.

41.   **As to claim 59,** the rejection of claim 2 above is incorporated herein in full.

Additionally, Cullen further teaches receiving the process-container from the at least one remote

entity *(the agent-manager agent then travels to the user's computer... arrives at the user's*

computer...presents its tailored interface to the user; col.5, lines 7-10); and displaying contents

of the process-container *(presents representations of the agents to the user; col.4, line 60)*. A

processor is inherent to the system of Cullen.

42.   **As to claim 60,** the rejection of claim 2 above is incorporated herein in full.

Additionally, Cullen further teaches a data processing system *(a computer system; see the*

Abstract); a fourth module operable to receive the process-container from the at least one remote

entity *(the agent-manager agent then travels to the user's computer... arrives at the user's*

computer...presents its tailored interface to the user; col.5, lines 7-10); and a fifth module

operable to display contents of the process-container *(presents representations of the agents to*

the user; col.4, line 60). A processor is inherent to the system of Cullen.

43.   **As to claim 61,** the rejection of claim 2 above is incorporated herein in full.

Additionally, Cullen further teaches means for receiving the process-container from the at least

one remote entity *(the agent-manager agent then travels to the user's computer... arrives at the*

user's computer...presents its tailored interface to the user; col.5, lines 7-10); and means for

displaying contents of the process-container *(presents representations of the agents to the user;*

col.4, line 60).

44.   **As to claim 62,** the rejection of claim 2 above is incorporated herein in full.

Additionally, Cullen further teaches means for performing the at least one task on the at least one

remote entity *(allows the user...perform a particular task; col.5, lines 36-60)*.

45.   **As to claim 63,** Cullen teaches means for receiving the process-container from the at

least one remote entity *(the agent-manager agent then travels to the user's computer... arrives at*

the user's computer...presents its tailored interface to the user; col.5, lines 7-10); and means for

displaying contents of the process-container *(presents representations of the agents to the user;*

col.4, line 60).

Conclusion

46.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Koike et al. (US 6742181 B1) "Inter-application data transmitting/receiving system and

method"

Jagannathan et al. (US 6496871 B1) "Distributed agent software system and method

having enhanced process mobility and communication in a computer network"

Kawamura et al. (US 6477563 B1) "Agent system and information processing method for

same"

Suzuki et al. (US 6434595 B1) "Method of executing mobile objects and recording

medium storing mobile objects"

Whitebread et al. (US 6148327 A) "Mobile agent docking arrangement for enhancing

agent capabilities"

Tahara et al. (US 6134580 A) "Data-processing apparatus, data-processing method, and

storage medium onto which is stored a data-processing program"

Mima et al. (US 6065040 A) "Computer system having agent retracting method and agent returning method"

Paciorek (US 6065039 A) "Dynamic synchronous collaboration framework for mobile agents"

Devarakonda et al. (US 6055562 A) "Dynamic mobile agents"

Frew et al. (US 6009456 A) "Information exchange by intelligent mobile agents in a network"

Runge et al. "The management of business transactions through electronic contracts" 1999 IEEE, pp. 1-8.

Sylvanus "A n agent-based system for distributed transactions: a model for Internet-based transactions" 1999 IEEE, pp. 289-294.

Vogler et al. "Distributed Transaction processing as a reliability concept for mobile agents " 1997 IEEE, pp. 59-64.

47.   Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (571) 272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM - 6:00PM. The examiner can also be reached on alternative Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Meng-Ai An can be reached on (571) 272-3756.

The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:
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